

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Gross)	Art Unit: 3625
)	
Serial No.: 10/770,937)	<u>Examiner: Rosen, Nicholas</u>
)	
Filed: 02/2/2004)	
)	
For: <i>Method of providing access to playable media</i>)	

Reply Brief

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants submit the present Reply Brief in furtherance of the Notice of Appeal filed in this case on December 11, 2007 and in response to the Examiner's Answer of March 28, 2008.

Argument

Appellant notes that the Examiner Answer still fails to explain how the references meet the limitation of claim 1, including that the:

.....subscriber delivery queue is maintained automatically for the subscriber so as to include at least one playable media item which could be delivered to such subscriber

All that the Examiner notes is that Hastings shows that titles can be recommended to subscribers which may or may not be accepted or delivered. That is clearly not the same as maintaining at least one item automatically for delivery as set out in claim 1, even if the Examiner believes that the likelihood of a subscriber turning down all recommendations is "unlikely to arise." See Answer page 22. Appellant submits that the Examiner's Answer clearly acknowledges that the prior art does *not* address let alone explain how to solve this problem.

Secondly the Examiner suggests that Hastings describes “monitoring” because he examines whether certain items are, or in the past have been, in the queue. See answer page 21. That does not meet the requirements of the claim, which plainly states that, first, the monitoring step is done based on a set of queue replenishment control rules, and further achieves the objective of determining:

..... if an additional playable media item should be added to said subscriber delivery queue...

Simply “monitoring” to see what items may or may not have been in the queue - as the Examiner claims Hastings provides - would not achieve this result, and plainly has nothing to do with queue replenishment rules.

Finally the Examiner again insists that Ostrom’s suggestion to subscribers that they can manually add titles to their queues somehow cures the defects in Hastings. By the Examiner’s reckoning the *automatic* selection of such titles on behalf of the subscriber – based on certain user queue replenishment rules - is not distinguishable because in his opinion, an automatic means to replace a manual activity is automatically “obvious” to one skilled in the art. See page 20 of the Answer.

By this logic the Appellant notes that almost every electronic and computing device manufactured today could have no patentable components, because every computation and function is one that replaces a manual activity. An automatic cruise control for a vehicle would not be patentable, because a human could be instructed of course to keep the pedal at a certain speed. Automated alarms would not be patentable because a human could merely pay attention to the event in question to determine if action was required. Search engines would not be patentable, because users could simply find all the information on their own – manually. And so on and so on. Yet, clearly, this is not the standard, and never has been.

Appellant submits that the Examiner paints too broad a brush with his suggestion in this respect. The plain reality is that there is no reference or teaching that hints at the type of function proposed in claim 1, despite the fact that the Examiner has clearly researched this art and noted the need for this type of capability. Under the circumstances the Appellant submits that the record is not sufficient in fact to demonstrate obviousness.

The above logic applies equally to independent claims 35 and 36, and is incorporated by reference along with the discussion provided in the Appeal brief. In addition for claim 35 Appellant does not see where Hastings does anything to analyze content of titles in the queue during a monitoring step. At most, as the Examiner notes, Hastings is given criteria by the subscriber for the titles.

For claim 36 Appellant merely notes again that the Examiner is reading too much into Hastings; merely securing preference data is not the same as giving recommendations a term which is understood in the art to require some form of prediction. Hastings, in this respect, does not "predict" anything; it merely follows specific directions on titles, actors, etc.

As concerns the other claims, Appellant relies on the arguments of record. Based on the above Appellant submits that the rejections should be reversed and the past approved for allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J. Nicholas Gross". The signature is fluid and cursive, with the first name "J." being more distinct than the last name "Gross".

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